



20 OCT 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
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Charles I. Sherman  
MIDDLETON RAUTLINGER  
2500 Brown & Williamson Tower  
Louisville, Kentucky 40202

In re Application of:  
DA SILVA RODRIGUES, et al.  
U.S. Application No.: 10/581,774  
PCT No.: PCT/IB2004/004350  
Int'l Filing Date: 10 December 2004  
Priority Date: 11 December 2003  
Attorney's Docket No.: SC3  
For: SMOKING ARTICLE

DECISION

This decision is issued in response to the declaration filed herein by applicants and the "Notice Of Death Of Joint Inventor Under MPEP 409" filed 29 August 2006. No petition fee is required.

**BACKGROUND**

On 10 December 2004, applicants filed international application PCT/IB2004/004350. The application claimed a priority date of 10 December 2004, and it designated the United States. On 30 June 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 11 June 2006.

On 06 June 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the small entity basic national fee and a copy of a PCT Rule 4.17(iv) declaration filed in the international application and executed by both of the inventors herein.

On 29 August 2006, applicants filed additional materials, including a "Notice Of Death Of Joint Inventor Under MPEP 409" indicating that inventor Antonio Augusto DA SILVA RODRIGUES was now deceased.

**DISCUSSION**

The PCT Rule 4.17(iv) declaration document filed by applicants during the international phase was not submitted at the same time as the international application. Accordingly, as set forth on the face of the declaration (and in the instructions thereto), the declaration was required to identify the international application number. The declaration executed by the two inventors and filed in the international application did not, however, include the required international

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application number. The declaration therefore fails to properly identify the application to which it was directed and cannot be accepted herein in satisfaction of the requirements of 37 CFR 1.497.

It is noted that applicants included with the national stage materials filed 06 June 2006 a copy of the PCT Rule 4.17(iv) declaration that lists the international application number. However, a comparison of this declaration with that filed in the international phases reveals that the international application number has simply been added to the already-executed declaration. The declaration filed on 06 June 2006 therefore includes an impermissible post-execution modification, and is thus unacceptable (see MPEP section 602.01).

Based on the above, applicants have not yet filed an acceptable declaration in compliance with 37 CFR 1.497. A Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration, as well as the surcharge for filing the oath or declaration later than thirty months after the priority date, will be issued herein.

Because one of the applicants is now deceased, any declaration filed herein must be executed by the surviving inventor and on behalf of the deceased inventor in compliance with 37 CFR 1.42 and 1.497(b)(2).

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Pursuant to MPEP section 409.01(a), application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), a declaration submitted under 37 CFR 1.42 must provide the name, citizenship, residence and mailing address of the legal representative, as well as the name and citizenship of the deceased inventor. The declaration must also satisfy all other requirements of 37 CFR 1.497 (for example, the declaration must name all of the inventors herein).

**CONCLUSION**

The declaration filed in the international phase, and the modified version of this declaration filed herein on 06 June 2006, are **REJECTED** for failure to comply with the instructions for declarations filed under PCT Rule 4.17(iv) and the requirements of 37 CFR 1.497.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of a properly executed oath or declaration (submitted in accordance with 37 CFR 1.42 with respect to the deceased inventor), as well as the surcharge for filing the oath or declaration later than thirty months after the priority date



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Office of PCT Legal Administration  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: )  
Da Silva Rodrigues et al. )  
Serial No.: 10/581,774 )  
Filed: June 6, 2006 )  
Earliest Priority Filing Date: 11 December 2003 )  
International Filing Date: 10 December 2004 )  
PCT Application No.: PCT/IB2004/004350 )  
For: SMOKING ARTICLE )

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**NOTICE OF DEATH OF JOINT INVENTOR UNDER MPEP § 409**

Dear Sirs:

This is notice that one of the joint inventors herein, Antonio Augusto da Silva Rodrigues, is now deceased. Attached are the death certificate and the Statutory Declaration from the second and surviving inventor, Mr. Eduardo José Faria Miranda confirming that subsequent to the signing of the Declaration of Inventorship, Mr. Rodrigues has died.

An Assignment document assigning the invention to Souza Cruz, S.A., the employer of both joint inventors at the time of the filing of the priority application, and executed only by Mr. Miranda, is also being submitted to the U.S. Patent Office, under separate cover, to be recorded with the U.S. Patent Office.

Further prosecution of this application will be undertaken on behalf of the assignee, Souza Cruz, S.A. Please enter this information into the record of the above referenced patent application.

Respectfully submitted,



---

Charles I. Sherman, Reg. No. 22,998  
MIDDLETON REUTLINGER  
Ph (502) 625-2745

SMOKING ARTICLE  
Inventor: Da Silva Rodrigues et al. .  
Atty. Dkt.: SC3

Date: August 28, 2006

2500 Brown & Williamson Tower  
Louisville, Kentucky 40202  
csherman@middreut.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Miranda et al.

)

) Examiner: Not Assigned

)

PCT Serial No. PCT/IB2004/004350

)

) Unit: Not Assigned

PCT File Date: December 10, 2004

)

U.S. Serial No.: Not Determined Yet

)

U.S. Filing Date: June 6, 2006

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)

For: Smoking Article

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**STATUTORY DECLARATION OF SURVIVING INVENTOR**

**Under 28 U.S.C. § 1746, MPEP 602II and 409.01(f)**

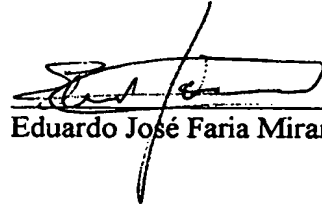
Dear Sirs:

1. My name is Eduardo José Faria Miranda and I am a co-inventor in the above-identified application, together with Antonio Augusto da Silva Rodrigues.
2. Both I and Mr. Rodrigues, at the time this invention was made, were employees of Souza Cruz S.A., a Brazilian company having a post office address at Rua Candalaria, 66, Rio de Janeiro, Brazil.
3. Both I and Mr. Rodrigues have executed a Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis1(a)(iv) in this application.
4. Subsequent to signing the Declaration of Inventorship, Mr. Rodrigues has died, as confirmed by the attached Atestado de Óbito (or affidavit by a medical doctor).
5. Accordingly, I have signed an individual Assignment of Invention and Letters Patent to Souza Cruz, S.A. as required by the conditions of our employment by that company.



I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Eduardo José Faria Miranda', is written over a horizontal line.

Eduardo José Faria Miranda

Executed on 27<sup>th</sup> July, 2006.

AMOROSO - RJ / ARSON - RJ / COLLIERIO NOTARIAL



REPÚBLICA FEDERATIVA DO BRASIL  
RICARDO DIMAS RAMOS CARNEIRO

TRADUTOR PÚBLICO E INTÉRPRETE COMERCIAL  
SWORN PUBLIC TRANSLATOR and COMMERCIAL INTERPRETER

Rua Real Grandeza, 193 ap. 601, Botafogo - Rio de Janeiro - RJ - 22281-035 - Tel: (21) 2538-8817 / 2537-8387  
Matrícula JUCERJA nº 166 - RG nº 2.336.245 IFP - CPF 273.535.757/00 - e-mail: ricardodimas@openlink.com.br

I, the undersigned, a Sworn Public Translator and Commercial Interpreter in and for this City of Rio de Janeiro, State of Rio de Janeiro, Federative Republic of Brazil, duly appointed by Administrative Rule no. 692 of April 11, 2006, issued by the President of the Board of Trade of the State of Rio de Janeiro, DO HEREBY CERTIFY AND ATTEST, that a document written in PORTUGUESE was presented to me for translation into ENGLISH, which I have lawfully performed, by reason of my official capacity, as follows: -----

-----TRANSLATION No. 0047 -----

Arms of the Federative Republic of Brazil -  
FEDERATIVE REPUBLIC OF BRAZIL - EIGHTH CIVIL  
REGISTRY OF INDIVIDUALS OF THE CAPITAL OF THE  
STATE OF RIO DE JANEIRO - Address: Av. N. S.  
Copacabana, 1151, Copacabana, Rio de Janeiro - RJ  
- Brazil --- Alan J. S. Borges - Official  
Registrar - Transcript of a DEATH CERTIFICATE -----

I CERTIFY that, in book 0615-C, on page 283, under no. 141367, there appears the entry regarding the death of ANTONIO AUGUSTO DA SILVA RODRIGUES, deceased on February 12, 2005, at 11:30 AM, at Clinic São Vicente (Saint Vincent), in Gávea, Rio de Janeiro, RJ, Brazil, resident and domiciled at Rua Paulo Emilio Gomes, 350, Jacarepaguá, Rio de Janeiro, RJ, Brazil, of male sex, white color, pharmacist, married to Nadia Maria de Almeida Rodrigues, aged 52, born in Portugal, son of Manuel Rodrigues and Maria Emilia da Silva. The

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REPÚBLICA FEDERATIVA DO BRASIL  
RICARDO DIMAS RAMOS CARNEIRO

TRADUTOR PÚBLICO E INTÉRPRETE COMERCIAL

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decedent left property. He was not elector and any  
'testament and last will' is unknown. The decedent  
left three (3) children of age. The death  
certificate was signed by Dr. Dante Pagnoncelli,  
enrolled with the Regional Council of Medicine  
under no. 52313613, who attested as *causa mortis*:  
respiratory insufficiency, pulmonary carcinomatous  
lymphangitis, osseous and cerebral metastasis,  
lung cancer, with authorization for burying before  
elapsed 24 hours after death. Registration made on  
February 15, 2005. The burial was made at  
Pechincha Cemetery. Laura Bezerra Dias Azevedo was  
the declarant. Registration made as per  
declaration of death no. 06419694. Remarks:  
Decedent's identification document RG no. 64704-H  
RNE. -----

I (signature) Gilberto Peralta Pereira, Clerk,  
prepared this document. IN WITNESS WHEREOF. -----  
Rio de Janeiro, February 15, 2005. -----

Signed: Gilberto Peralta Pereira, Authorized Clerk  
- Record no. 94/1178-CGJ-RJ -----

No emoluments were charged. -----  
THERE APPEARS an obliterated Notarial Seal under  
no. 79221. -----

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REPÚBLICA FEDERATIVA DO BRASIL  
RICARDO DIMAS RAMOS CARNEIRO

TRADUTOR PÚBLICO E INTÉRPRETE COMERCIAL  
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THE ABOVE was the full text of said document, the translation of which was set forth on 3 (three) pages. -----

IN WITNESS WHEREOF, I set my hand and seal of office in Rio de Janeiro, RJ, Brazil, on July 24, 2006. -----

*Ricardo Dimas Ramos Carneiro*



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**ASSIGNMENT OF INVENTION**  
**AND OF LETTERS PATENT**

Whereas, I, (the "Inventor"), **Eduardo José Faria Miranda**, residing at Av. Dom Hélder Câmara, 2066, Vieira Fazenda, Rio de Janeiro, RJ, 210590900, Brazil, have invented certain improvements in a **SMOKING ARTICLE**, (the "Invention"), and have executed a U.S. utility patent application for United States Letters Patent of the same title, herewith (the "Application"), which was filed on June 6, 2006. The Application claims priority to and benefit from as a 35 U.S.C. § 371 as a national stage filing of PCT/IB2004/004350, filed on December 10, 2004, which claims priority to and benefit from, currently pending, Great Britain Patent Application Serial Number GB0328644.0, filed on December 11, 2003; and,

Whereas, (the "Assignee"), **Souza Cruz S.A.**, a Brazilian company (including its successors and assigns), whose post office address is Rua Candelária, 66, Rio de Janeiro, Brazil, desires to acquire my entire right, title and interest in said Application and Invention, and any United States and foreign patents to be obtained therefor;

Now therefore, for good and valuable consideration, the receipt of which is hereby acknowledged, I hereby sell, assign and transfer unto said Assignee, the entire right, title and interest in said Application and the Invention disclosed therein for the United States of America, including rights of priority under the International Convention of Paris (1883) as amended and the entire right, title, and interest in and to any and all patent applications, patents, continuations, continuations-in-part, divisionals, and reissues based thereon which may be filed or granted therefor in the United States. I also agree that Assignee, may apply for foreign Letters Patent on the Invention, and I agree to cooperate with Assignee, and to execute without additional consideration any additional documents as deemed necessary by Assignee, to apply for or maintain patents or other legal protection for the Invention in the United States of America.

I hereby authorize and request the U.S. Commissioner of Patents and Trademarks

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*GF*

to issue any Letters Patent granted upon the invention set forth in this Application to said Assignee.

  
Eduardo José Maria Miranda

Executed this 27<sup>th</sup> day of July, 2006 in Rio de Janeiro, Brazil.

  
Witness #1

(type/print name & address)

Gabriel Valério França

Av. Rio Branco, 45 sala 2011 e 2012

Centro - CEP: 20090-003

Rio de Janeiro - RJ - Brasil

  
Witness #2

(type/print name & address)

Custódio March Alvim

Av. Rio Branco, 45 sala 2011 e 2012

Centro - CEP 20090-003

Rio de Janeiro - RJ - Brasil

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